



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/773,492	02/06/2004	Sara Elizabeth Caldwell	2003/04	6638

7590 03/17/2006

Gregory N. Clements  
KOSA  
4501 Charlotte Park drive  
Charlotte, NC 28217-1979

EXAMINER

BOYKIN, TERRESSA M

ART UNIT	PAPER NUMBER
----------	--------------

1711

DATE MAILED: 03/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b>	Application No.	Applicant(s)	
	10/773,492	CALDWELL, SARA ELIZABETH	
	Examiner	Art Unit	
	Terressa M. Boykin	1711	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 02 March 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

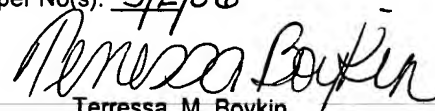
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: \_\_\_\_\_.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

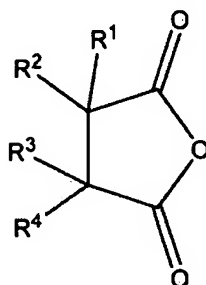
11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See attached response  
12. ☒ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). 3/2/06  
13. ☐ Other: \_\_\_\_\_.

  
Terressa M. Boykin  
Primary Examiner  
Art Unit: 1711

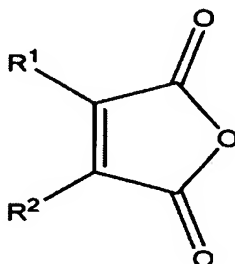
### **Response to Arguments**

Applicant's arguments filed 3-2-06 have been fully considered but they are not persuasive. In response to Applicant's arguments it is evident that applicants have completely misunderstood and taken literally the phrase "substituted cyclic anhydride" as being the crux of the argument. As stated in the previous response, the substitutions a) through f) as set forth on pages 9-13 of applicants own specification as are not clearly defined nor set forth in applicants claims

#### **a) substituted succinic anhydrides**

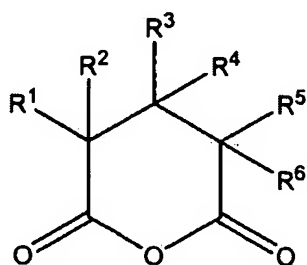


#### **b) substituted maleic anhydride**

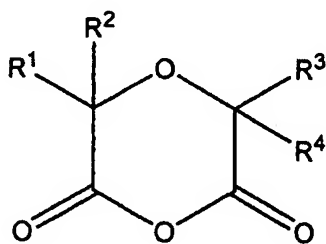


where R<sup>1</sup> and R<sup>2</sup> can be hydrogen, alkyl, alkenyl or aryl groups, and at least one group is not hydrogen.

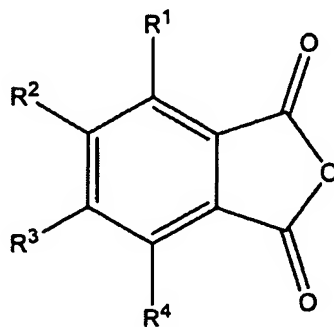
**c) substituted glutaric anhydride**



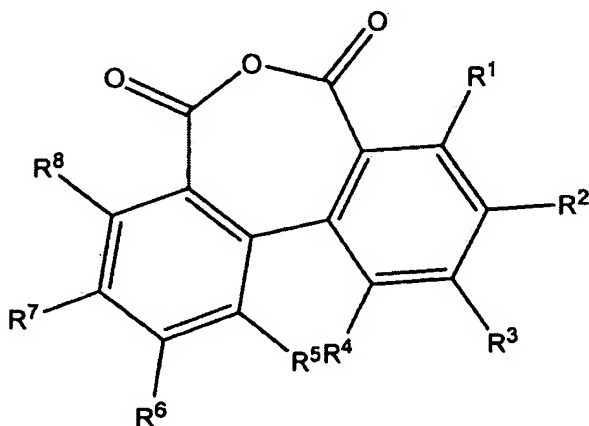
**d) diglycolic anhydride and substituted diglycolic anhydride**



**e) Substituted phthalic anhydride**



**f) diphenic anhydride and substituted diphenic anhydride**



**The inclusion of the moieties a0 through f) would clearly support and distinguish the anhydride from that of the prior art of record.**

The fact, that the reference states cyclic anhydride does not ***automatically exclude*** those which are substituted. Cyclic anhydride means simply that the anhydride must be cyclic. No other limitations are inferred or excluded. Thus, the term “cyclic anhydride” which could include substituted/unsubstituted etc... without a clear moiety as set forth in applicants won a) through f) the reference continues to anticipate the claimed I invention.

Again, applicant(s) are also reminded that patentability cannot be predicated

upon an advantage or result that has not been satisfactorily expressly, or least implicitly, disclosed in the application as filed. Clinical Products v. Brenner, 255 F. Supp. 131, 149 U.S.P.Q. 475, 480 (D.D.C. 1966) Therefore, it is irrelevant whether the reference(s) includes (**or excludes**) those features or not.

The rejection is repeated for applicant's convenience:

**Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-20 are rejected under 35 U.S.C. 102(b) as being anticipated by USP 6342578 see abstract, col. 4 lines 10 through col. 5, tables 1-4, cols. 11 lines 28-40, and claims 1-14.

**USP 6342578** discloses a composition comprising: a copolyester of polyethylene terephthalate and a dicarboxylic acid or its ester equivalent, and not more than 100 microequivalents per gram of said copolyester of an anhydride selected from the class consisting of succinic, glutaric, benzoic, maleic and phthalic anhydride, said

composition having a CEG content greater than about 25 microequivalents per gram and an IV greater than about 0.65. The reference also discloses a method of making a composition having reduced caustic stress cracking, comprising: reacting terephthalic acid or its ester equivalent and another dicarboxylic acid with ethylene glycol by esterification followed by polycondensation to make a polyethylene terephthalate copolyester; adding at the end of said polycondensation not more than 100 microequivalents per gram based on said copolyester of an anhydride selected from the class consisting of succinic, glutaric, maleic, benzoic, and phthalic anhydride, said composition having a CEG content greater than about 25 microequivalents per gram.

Thus, the reference discloses a polymer resin prepared from the same components as claimed by applicants. Each of the limitations in the claims are clearly found throughout the reference and as cited specifically above; i.e. col. 4 lines 10 through col. 5, tables 1-4, cols. 11 lines 28-40, and claims 1-14, as well as using the resin for making containers. Consequently, the claimed invention cannot be deemed as novel and accordingly is unpatentable.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### **Correspondence**

**Please note that the cited U.S. patents and patent application publications are available for download via the Office's PAIR. As an alternate source, all U.S. patents and patent application publications are available on the USPTO web site ([www.uspto.gov](http://www.uspto.gov)), from the Office of Public Records and from commercial sources. Applicants may be referred to the Electronic Business Center (EBC) at <http://www.uspto.gov/ebc/index.html> or 1-866-217-9197.**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Terressa Boykin whose telephone number is 571 272-1069. The examiner can normally be reached on Monday through Friday from 6:30am to 3:00pm.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. The general information number for listings of personnel is ( 571-272-1700).

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.



Art Unit: 1711

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

tmb

**Examiner Terressa Boykin**

**TERRESSA M. BOYKIN  
PRIMARY EXAMINER**